

**REMARKS**

Claims 1-37 are pending in this application. By this Amendment, claims 1, 14, 26-29 and 31-36 are amended. No new matter is added. Reconsideration is respectfully requested.

Applicants submit that the claim amendments are made to clarify the scope of the subject matter claimed, and not to distinguish over any applied art. The claims are not narrowed by such amendments.

The Office Action rejects claims 14-37 under 35 U.S.C. § 112, second paragraph. By this Amendment, claims 14, 26-29 and 31-36 are amended, thereby obviating this grounds of rejection. Applicants respectfully request that the rejection of claims 14-37 under 35 U.S.C. § 112, second paragraph be withdrawn.

The Office Action rejects claims 1-37 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,173,287 to Eberman et al. (hereinafter "Eberman"), in view of U.S. Patent No. 5,832,474 to Lopresti et al. (hereinafter "Lopresti"). This rejection is respectfully traversed.

The Office Action admits that Eberman does not disclose "generating at least one annotation using an annotation device and an input device independently, while displaying at least one object with a viewing device that is distinct from the annotation device," and relies on Lopresti to allegedly supply the missing subject matter.

The Office Action states "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lopresti and Eberman because Lopresti's teaching would have provided the capability for allowing the users to create and view the annotations in different media." Applicants submit that this stated motivation appears to be based on impermissible hindsight because only the present application discloses such a capability. Thus, the Office Action appears to improperly rely on Applicants' own disclosure, rather than a suggestion, teaching, or motivation found in the references themselves.

For example, nowhere in Eberman is there a suggestion or teaching that generating one annotation using an annotation device and viewing device that is distinct from the annotation device would "provide the capability for allowing the users to create and view the annotations in different media." Similarly, there is no suggestion or teaching in Lopresti that using a pen 22 and digitizing tablet 24 in a system which obtains an object identifier for at least one object, generates at least one annotation, and establishes a link between the annotation and the object, yields any such advantage. The only disclosure which teaches the desirability of allowing users to create and view the annotations in different media is that of the present application.

The specification of the present application, for example on page 1, line 21 through page 2, line 30 describes various scenarios in which it is advantageous to have the annotation device distinct from the viewing device.

It is well established that it is impermissible for an Examiner to engage in hindsight reconstruction of the claimed inventions using the Applicants' disclosure as a template and selecting elements from the reference to fill the page. The references themselves must provide some teaching whereby the Applicants' combination would have been obvious. *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

It is respectfully submitted that the Office Action impermissibly engages in hindsight reconstruction of the claimed invention. Because the Office Action fails to set forth a proper motivation for making the asserted combination, the Office Action fails to establish a *prima*

*facie* case of obvious. Applicants therefore respectfully request that the rejection of claims 1-37 under 37 U.S.C. § 103 (a) be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

Jaquelin K. Spong  
Registration No. 52,241

JAO:JKS/tbh

Attachments:

Petition for Extension of Time  
Request for Continued Examination

Date: September 27, 2004

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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